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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HOLME ROBERTS & OWEN, LLP			DANG, HUNG XUAN	
299 SOUTH MAIN			ART UNIT	
SUITE 1800			PAPER NUMBER	
SALT LAKE CITY, UT 84111			2873	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,761

Applicant(s)

JACKSON ET AL.

Examiner

Hung X Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

There are two claims 4 in this application. Base on the requirement of 37 CFR 1.126, the second claim 4 and claims 5-50 have been renumbered as claims 5-51 base. Applicant should note this change in any future.

Information Disclosure Statement

1. The Information disclosure Statements filed on 2/17/04 has been considered.

Claims Objection

2. Claim 5 is objected to because of the following informalities:

In claim 5, line 2, "the eye socket a user" should be changed to --the eye socket of the user--.

In claim 33, line 3, after "said frame" should be inserted semicolon.

Appropriate correction is required.

Claims Rejection Under 35 USC - 112

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, "a casing conFIG.d" is indefinite.

In claim 4, line 8, "a casing conFIG.d" is indefinite.

In claim 28, line 9, "casing conFIG.d" is indefinite.

Claims Rejection Under 35 USC - 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 12, 23, 29, 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Chao** (5,631,716).

Chao discloses sport goggles having prescription lens comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein, wherein said rim member has a rim ridge extending toward said lens area and wherein said casing has a groove formed therein sized to effect a snap fit with said rim ridge upon positioning said lens unit in said lens receiving portion.

Claims Rejection Under 35 USC – 103

5. Claims 24-28 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,631,716) in view of **Neef** (4,802,754).

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Chao discloses sport goggles having prescription lens comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein, wherein said rim member has a rim ridge extending toward said lens area and wherein said casing has a groove formed therein sized to effect a snap fit with said rim ridge upon positioning said lens unit in said lens receiving portion.

Chao does not disclose a detachable nose pad.

Neef, however, discloses a detachable nose pad.

Because Chao and Neef are all from the same field of endeavor, the purpose of bracing the spectacles frame on the nose of the wearer in a soft and slip-free manner as disclosed by Neef would have been recognized as an art pertinent art of Chao.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Chao, with the a detachable nose pad, such as disclosed by Neef for the purpose of bracing the spectacles frame on the nose of the wearer in a soft and slip-free manner.

Claims Rejection Under 35 USC - 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-11, 31-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Nishiyama** (5,093,940).

Nishiyama discloses lens exchangeable goggle comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein, wherein said frame is spaced from the outer surface of the eye socket of a user a seal distance when said frame is positioned proximate the eyes of a user, wherein said eyewear device further includes a seal member attached to said casing, said seal member being sized and shaped to extend from said casing toward said eye socket of a user.

Claims Rejection Under 35 USC - 102

7. Claims 34 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Smerdon, Jr** (6,092,897).

Smerdon, Jr discloses adjustable retainer for eyeglass comprises a comprises a frame, a lens for positioning in front of an eye of a user, the lens being attached to the frame; first and second elongate extensions rotatably attached to said frame to be movable from a deployed position to a stored position, said first elongate extension including a first aperture and said second elongate extension including a second aperture; and a retaining strap having a first end and second end with a stretch there between, said first end being attachable to said first aperture and the second end being attachable to said second aperture.

Claims Rejection Under 35 USC – 103

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Smerdon, Jr** (6,092,897) in view of **Gill** (5,087,118).

Smerdon, Jr discloses adjustable retainer for eyeglass comprises a comprises a frame, a lens for positioning in front of an eye of a user, the lens being attached to the frame; first and second elongate extensions rotatably attached to said frame to be movable from a deployed position to a stored position, said first elongate extension including a first aperture and said second elongate extension including a second aperture; and a retaining strap having a first end and second end with a stretch there between, said first end being attachable to said first aperture and the second end being attachable to said second aperture.

Smerdon, Jr does not disclose the leash for securing the eyewear device to the cloth.

Gill, however, discloses that the leash for securing the eyewear device to the cloth.

Because Smerdon, Jr and Gill are all from the same field of endeavor, the purpose of securing the eyewear device to the cloth as disclosed by Gill would have been recognized as an art pertinent art of Smerdon, Jr.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Smerdon, Jr, with the leash, such as disclosed by Gill for the purpose of securing the eyewear device to the cloth.

Claims Rejection Under 35 USC – 102

9. Claims 36-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipate by **Bonacci** (6,513,925).

Bonacci discloses snug fitting floating eyeglass comprises a frame for positioning proximate the eyes of a user, said frame including a lens-receiving portion; an eyeglass lens means for positioning in front of an eye of a user, said eyeglass lens being connected to said frame to be in said lens receiving portion; a first elongate extension and a second elongate extension each connected to said frame to extend toward the user's ears with said frame positioned proximate the eyes of a user; said first and said second elongate extensions each having an interior surface oriented toward the head of the user when said frame is positioned proximate the eyes of the user, at least one head grip aperture formed in said first and said second elongate extensions

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each head grip aperture being sized to receive a head grip; and at least one head grip positioned in one of said head grip apertures, said head grip being sized and shaped to extend away from said interior surface of said first and said second elongate extension to frictionally contact the head of a user when said eyewear device is positioned on the head of a user.

Claims Rejection Under 35 USC - 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gaspari** (4,021,103) in view of **Bonacci** (6,513,925).

Gaspari discloses ophthalmic mounting arrangement comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein.

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Gaspari does not disclose the head grip contacting the head of the user.

Bonacci, however, discloses that the head grip contacting the head of the user.

Because Gaspari and Bonacci are both from the same field of endeavor, the purpose of holding the goggle in the head of the wearer as disclosed by Bonacci would have been recognized as an art pertinent art of Gaspari.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by, Gaspari with the head grip, such as disclosed by Bonacci for the purpose of holding the goggle in the head of the wearer.

Claim Rejections Under 35 USC – 103

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaspari (4,021,103) in view of Bonacci (6,513,925) as applied to claims 13-21 above, and further in view of Gill (5,087,118).

Gaspari and Bonacci discloses lens exchangeable goggle comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein and the head grip contacting the head of the user.

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Gaspari and Bonacci do not disclose the leash for securing the eyewear device to the cloth.

Gill, however, discloses that the leash for securing the eyewear device to the cloth.

Because Gaspari, Bonacci and Gill are all from the same field of endeavor, the purpose of securing the eyewear device to the cloth as disclosed by Gill would have been recognized as an art pertinent art of Gaspari and Bonacci.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Gaspari and Bonacci, with the leash, such as disclosed by Gill for the purpose of securing the eyewear device to the cloth.

Claims Rejection Under 35 USC - 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims, 1-4 and 47 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Gaspari** (4,021,103).

Gaspari disclose ophthalmic mounting arrangement comprises a frame for positioning proximate the eyes of a user, said frame having an inner surface oriented

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toward the eyes of a user and an outer surface spaced from said inner surface and oriented outwardly and away from said frame and the eyes of said user, said frame having a first rim defining a first lens area and a second rim defining a second lens area, said first rim having a first rim ridge extending toward said first lens area and a second rim having a second rim ridge extending toward said second lens area; a first lens unit having a first casing having a first lens frame configured to receive and retain a first eyeglass lens and a first groove sized to effect a snap fit with said first rim ridge upon positioning of said first lens frame in said first lens area, said first lens unit being configured for removable attachment and positioning in one of said lens receiving portions only through said inner surface; a second lens unit having a second casing having a second lens frame configured to receive and retain a second eyeglass lens and a second groove sized to snugly and slideably receive said second rim ridge upon positioning of said second lens frame in said second lens area, said first lens unit being configured for removable attachment and positioning in one of said lens receiving portions only through said outer surface; and a first elongate extension and a second elongate extension each rotatably connected to said frame to extend toward the user's ears with said frame positioned proximate the eyes of a user; said first and said second elongate extensions each being movable from a deployed position extending toward the ears of the user and a stored position displaced from said deployed position, said first and second extensions each having an interior surface oriented toward the head of the user when said frame is positioned proximate the eyes of the user.

Claims Rejection Under 35 USC - 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gaspari** (4,021,103) in view of **Bonacci** (6,513,925).

Gaspari discloses lens exchangeable goggle comprises a frame including lens receiving portion, means for retaining the frame proximate the eye of the user and a lens unit having eyeglass lens means for positioning in front of an eye of a user and a casing configured to receive and retain the eyeglass lens means, the lens unit being removably positionable in the lens receiving portion, wherein said lens-receiving portion includes a rim member defining a lens area to receive said lens unit therein and a first elongate extension and a second elongate extension each rotatably connected to said frame to extend toward the user's ears with said frame positioned proximate the eyes of a user; said first and said second elongate extensions each being movable from a deployed position extending toward the ears of the user and a stored position displaced from said deployed position, said first and second extensions each having an interior surface oriented toward the head of the user when said frame is positioned proximate the eyes of the user.

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Gaspari does not disclose the head grip contacting the head of the user.

Bonacci, however, discloses that the head grip contacting the head of the user.

Because Gaspari and Bonacci are both from the same field of endeavor, the purpose of holding the goggle in the head of the wearer as disclosed by Bonacci would have been recognized as an art pertinent art of Gaspari.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by, Gaspari with the head grip, such as disclosed by Bonacci for the purpose of holding the goggle in the head of the wearer.

Claims Rejection Under 35 USC - 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gaspari** (4,021,103) in view of **Bonacci** (6,513,925) as applied to claims 48-50 above, and further in view of Smerdon, Jr. (6,092,897).

Gaspari and Bonacci all the limitations of claimed invention with the exception of the retaining attached to the temple.

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Smerdon Jr, however, discloses the retaining attached to the temple.

Because Gaspari, Bonacci and Smerdon Jr are all from the same field of endeavor, the purpose of holding the goggle in the head of the wearer as disclosed by Smerdon Jr would have been recognized as an art pertinent art of Gaspari and Bonacci.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by, Gaspari and Bonacci with the retaining attached to the temple, such as disclosed by Smerdon Jr for the purpose of holding the goggle in the head of the wearer.

15. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

2/05



HUNG DANG

PRIMARY EXAMINER

TC 2800